IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	:	09/728,340	Confirmation No.:	5053
Applicant	:	Tom Vicknair		
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Title	:	ELECTRONIC CHECK PRESENTMENT SYSTEM AND METHOD HAVING AN ITEM SEQUENCE CAPABILITY		
TC/Art Unit	:	3628		
Examiner:	:	Harish T. Dass		
Docket No.	:	72167.000253		
Customer No.	:	**21967**		

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSIVE AMENDMENT

Sir:

Responsive to the Office Action mailed February 28, 2006, please amend the above-captioned application as set forth below.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (Previously Presented) A method of processing banking transactions comprising:

receiving an electronic cash presentment (ECP) file, the ECP file containing first records representing paper-based banking transactions;

for each of the first records, assigning a unique first item sequence number to each respective first record;

receiving the paper-based banking transactions after having received the ECP file;

generating second records representing the paper-based banking transactions;

generating digital images of the paper-based banking transactions;

for each of the second records, assigning a unique second item sequence number to each respective second record;

correlating the first and second records; and

discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.

2. (Original) The method according to claim 1, further comprising performing financial processing with respect to each of the first records.

3. (Original) The method according to claim 2, wherein the financial processing comprises posting the banking transaction.

4. (Original) The method according to claim 1, wherein the step of correlating the first and second records further comprises performing a proofing process.

5. (Original) The method according to claim 4, further comprising, prior to the proofing process, sorting the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process.

6. (Original) The method according to claim 5, wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction.

7. (Canceled)

8. **(Currently Amended)** The method according to claim ~~7~~ 1, further comprising storing the digital images in an archive.

9. (Original) The method according to claim 1, further comprising generating first digital images of paper-based banking transactions that were not represented in the ECP file.

10. (Original) The method according to claim 9, further comprising:

generating second digital images of the paper-based banking transactions that were represented in the ECP file; and

storing the first and the second digital images in an archive.

11.-35. (Canceled)

36. (Previously Presented) A system for processing banking transactions comprising:

a first processor, the first processor receiving an electronic cash presentment (ECP) file, the ECP file containing first records representing paper- based banking transactions, the first processor assigning a unique first item sequence number to each respective first record;

a second processor, the second processor receiving the paper-based banking transactions after the first processor received the ECP file, the second processor generating second records

representing the paper-based banking transactions, the second processor assigning a unique second item sequence number to each respective second record;

a scanner coupled to the second processor for generating digital images of the paper-based banking transactions; and

a third processor correlating the first and second records and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.

37. (Original) The system according to claim 36, wherein the first processor further performs financial processing with respect to each of the first records,

38. (Original) The system according to claim 37, further comprising an account system coupled to the first processor, wherein the financial processing by the first processor comprises posting the banking transaction in the account system.

39. (Original) The system according to claim 36, wherein the correlating by the third processor further comprises the third processor performing a proofing process.

40. (Original) The system according to claim 39, wherein, prior to the proofing process, the third processor sorts the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process by the third processor.

41. (Original) The system according to claim 40, wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction.

42. (Canceled)

43. (Original) The system according to claim 42, further comprising an archive coupled to the second processor, the archive storing the digital images.

44. (Original) The system according to claim 36, further comprising a scanner, the scanner generating first digital images of paper- based banking transactions that were not represented in the ECP file.

45. (Original) The system according to claim 44, wherein the scanner is a first scanner, the system further comprising:

a second scanner coupled to the first processor, the second scanner generating second digital images of the paper-based banking transactions that were represented in the ECP file; and

an archive coupled to the first processor, the archive storing the first and the second digital images.

46.-66. (Canceled)

REMARKS/ARGUMENTS

The Office Action of February 28, 2006, has been reviewed, and in view of the following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested. Claims 7, 11-35, 42 and 46-66 are canceled. Claims 1-6, 8-10, 36-41 and 43-45 remain pending. In response to the claim objection, claim 8 has been amended to change its dependency from claim 7 (now canceled) to claim 1. ***No new matter has been added.***

Specification Objections

The Specification is currently objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action alleges that the limitation "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number " is not supported by the specification. Applicants respectfully disagree.

According to MPEP 608.01(g), the description is a dictionary for the claims and should provide *clear support* or antecedent basis for all terms used in the claims. *See* 37 CFR 1.75. Further, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). The claim limitation as originally presented states "discarding the second item sequence numbers ***such that the second records are indexable according to the first item sequence number***." (emphasis added). Support for this claim limitation may be found in paragraph [0034] which states:

> "A further advantage of the prior art that will become more evident as described below, is that *a new ISN does not have to be generated for each physical item in the batch 40 from the transmitting bank 10.* ***Although such an ISN can be***

> ***generated by the sorters used in the capture process 10, this ISN can be disregarded once the internal processes of the capture processes 110 have been complete***."

Additional support is found in paragraphs [0037] as well as [0040] which state:

> In the most significant improvement over the prior art, the electronic file from the capture process 110 that documents the physical items that were received, contains the digital images of the physical items. This is significant since records associated with the digital images can be updated to reflect the standard ECP processing 25. *Specifically, as the digital images are matched to ECP items, the digital images are assigned the posting ISN and posting date given to the item when it was presented via the ECP process.*
>
> The present invention solves these problems with prior art by processing all Paper to Follow items in a strictly digital format. Most significantly, the digital images of the items, and the data records associated with the images are modified to reflect the financial processing (e.g., the posting date and posting ISN) that has occurred with respect to an item. *Since the digital records and images of the physical items are now linked directly to the ECP items, searching for an image of an item is a direct process.*

As supported by paragraph [0008], the ISN (Item Sequence Number) is unique for each item and serves as an *internal index* by which a bank can track an item. In addition, words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. MPEP 2111.01. It is believed that the specification as originally filed provides *clear support* for the originally presented claim limitation reciting "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number."

This objection to the specification is newly presented in the Office Action mailed February 28, 2006. Applicants respectfully request the Examiner to fully consider this response to this new objection to the Specification.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-6, 8-10, 36-41 and 43-45 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,930,778 to Geer ("Geer") in view of U.S. Patent No. 5,532,464 to Josephson ("Josephson"), U.S. Patent No. 5,678,046 to Cahill *et al* ("Cahill") and U.S. Patent No. 5,502,576 to Ramsay *et al* ("Ramsay").

Geer purports to disclose a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. In connection with example I, Geer specifically states that paper checks are not transported (column 6, lines 40-41). Information is extracted from the checks and converted into electronic form (column 6, lines 41-45). The physical checks are disposed of following the imaging and archival storage so that checks are truncated at the point of receipt (column 6, lines 41-49). As shown in Figure 1, papers checks are imaged at 7 and subsequently archived and destroyed at 9. The electronic information is scanned at 6. Geer fails to show a correlation between the electronic image at 7 and the scanned information at 6.

The Office Action admits the major deficiencies of Geer. More specifically, Geer fails to show at least the steps of "*correlating the first and second records.*" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number *wherein the second records and the digital images are linked to the first records by the first item sequence number.*"

In addition, Geer further fails to show "receiving the paper-based banking transactions after having received the ECP file."[1] The excerpt relied upon by the Office Action fails to show

[1] Office Action mailed February 4, 2005 admits that Geer does not disclose this limitation, see page 3.

that paper-based banking transactions are received ***after*** the ECP file. This limitation is clearly lacking in Geer. Further, none of the applied references disclose this missing feature.

The Office Action relies upon Josephson, Cahill and Ramsay for the admitted major deficiencies of Geer. Josephson correlates item sequence numbers assigned by other banks with different item sequence numbers (column 3, line 32 to column 5, line 9). Therefore, the checks are reconciled across different banks. The correlation across different banking schemes of Josephson is fundamentally different from the claimed correlation step of first records and second records. The Office Action has failed to address this major difference.

The Office Action turns to Cahill to teach "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." As shown in Figure 3 and 5, Cahill shows a storage device 202 at sort station 2 with a temporary storage of check images and associated data before the image is provided on network 3. After index records 28 are written, TIFF files 22 are deleted from storage space 505. Cahill does not assign a unique second item sequence number to second records, correlate the first and second records and further discard the second item sequence numbers such that records are indexable according to the first record number. The Office Action alleges that Cahill discloses that the TIFF files are deleted, but there is no mention of assigning a second item sequence number or discarding the second item sequence number. The Office Action has failed to show how deleting TIFF files in Cahill is equivalent to the claimed steps of "*for each of the second records, assigning a unique second item sequence number to each respective second record*;" "*correlating the first and second records*;" and "*discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein*

the second records and the digital images are linked to the first records by the first item sequence number."

Finally, the Office Action relies upon a fourth reference, Ramsay, to address the major deficiencies of Geer, Josephson and Cahill. Ramsay is directed to the transmission, storage and retrieval of documents in an electronic domain. Ramsay is not related to electronic check presentment or processing. Rather, Ramsay is directed to storage and retrieval of a two-dimensional electronic image expressible as a digital array or bitmap for the purpose of interactive document processing (abstract, col. 42, lines 59-64).

Based on these disclosures, the Office Action summarily concludes that it would have been obvious to combine the disclosures of Geer and Ramsay "to capture the image of an item and assign a sequence number to the image," without providing a basis for combining the disclosures. In addition, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson "to relate the image sequence number to serial number of the time (cross reference)," without providing any statement of motivation for making the suggested modification. Further, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson with Cahill "for improved database managing of document retrieval using indexed record." *See* page 5, Office Action mailed August 23, 2005. The Office Action has failed to provide a proper statement of motivation for combining four disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the

art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for combining Geer, Josephson, Cahill, and Ramsay has absolutely nothing to do with the deficiencies of Geer. As admitted by the Office Action, Geer fails to show at least the steps of "correlating the first and second records" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." To properly modify Geer to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Geer. Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Geer as taught by Josephson, Cahill and Ramsay, so the proposed modification fails. In fact, Geer, Josephson, Cahill and Ramsay are improperly combined and lack proper motivation. Even if the combination of Geer, Josephson, Cahill and Ramsay could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

The mere fact that Geer, Josephson, Cahill and Ramsay can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01*; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir.

1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Furthermore, the fact that four disparate references are needed in combination to address Applicants' claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, Chisum on Patents §5.04[I][e][6] (2002).

As the remaining dependent claims 2-6, 8-10, 37-41 and 43-45 encompass the limitations of independent claims 1 and 36, these claims should be allowed for at least the reasons stated above.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By: 

Yisun Song
Registration No 44,487

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Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)